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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,520	07/20/2001	Barbara L. Hempstead	19603/2595	9715

7590 10/20/2004

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EXAMINER

NICKOL, GARY B

ART UNIT PAPER NUMBER

1642

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,520

Applicant(s)

HEMPSTEAD ET AL.

Examiner

Gary B. Nickol Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,9,10,18,19,55,59 and 60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 9-10, 18-19, 55, 59-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1642

Re: Hempstead *et al.*

Date of priority: September 28, 1998

Response to Amendment

The Amendment filed 07-26-04 in response to the Office Action of 01-21-04 is acknowledged and has been entered.

Claims 7, 9-10, 18-19, 55, 59-60 are currently under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Rejection Maintained:

Claims 7, 9-10, 18-19, 55, and 59-60 remain rejected under 35 U.S.C. 102(e) as being anticipated by Alps *et al.* (US Patent No. 5,733,871, March 1995) for the reasons of record.

Applicant's arguments are accompanied by the Declaration of Joseph A. Madri (37 CFR 1.132) wherein Dr. Madri argues that before the present application was filed, it was not known that neurotrophic factors such as BDNF, NT-3, or NT-4 had the ability to promote blood vessel formation (para. 9) and that the teachings of the Alps patent would not have suggested such to scientists in the field. Dr. Madri argues that Alps relates to intravenous administration of the

Art Unit: 1642

neurotrophic factors for the purposes of treating or preventing neuronal damage as a consequence of ischemia, hypoxia, or neurodegeneration and that nowhere does Alps disclose inducing angiogenesis in a patient that has cardiac ischemia or a vascular disorder by administering BDNF, NT-3, or NT-4. Dr. Madri further notes that the examples used in the Alps patent (focal or global ischemia models) are used to induce neuronal damage and that “all Alps is doing with these neurotropic factors is what was well known in the art to used them for—treating neuronal conditions”.

These arguments have been carefully considered but are not found persuasive. While applicants may scientifically be correct, *i.e.* that the teachings of the Alps patent would not have suggested to scientists in the field that neurotrophic factors such as BDNF, NT-3, or NT-4 had the ability to promote blood vessel formation, such arguments are irrelevant to the inherent properties of administered neurotrophic factors as taught by Alps. Alps clearly teaches (column 4, line 55) that the methods and compositions are suitable for the “treatment of stroke or cardiac arrest which result in ischemic or hypoxic damage”. To reiterate, the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Thus, applicant’s arguments have not been found persuasive and the rejection is maintained.

All other rejections and or objections are withdrawn in view of applicant’s amendments and arguments there to.

Art Unit: 1642

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 571-272-0835. The examiner can normally be reached on M-Th, 8:30-5:30; alternate Fri., 8:30-4:30.

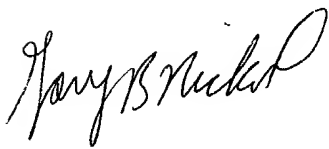
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1642

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary B. Nickol Ph.D.
Primary Examiner
Art Unit 1642

GBN

A handwritten signature in cursive script, appearing to read "Gary B. Nickol".

**GARY NICKOL
PRIMARY EXAMINER**